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Paper No.

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DEC 30 2004

OFFICE OF PETITIONS

In re Application of	:	
German Trabada, Russell Durgin and	:	
Robert Sakal	:	DECISION REFUSING STATUS
Application No. 10/753,848	:	UNDER 37 C.F.R. § 1.47(a)
Filed: January 8, 2004	:	
Title: ENDOLUMINAL ACCESS DEVICES	:	
AND RELATED METHODS OF USE	:	
Attorney Docket No. 10121/01301	:	
	:	

This is a decision on the "PETITION UNDER 37 C.F.R. § 1.47(a) TO FILE APPLICATION WITHOUT EXECUTED DECLARATION OF JOINT INVENTORS," filed November 26, 2004 (certificate of mailing Monday, November 22, 2004).

The petition is **DISMISSED**.

Rule 47 applicants are given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. § 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 C.F.R. § 1.136(a).

The above-identified application was filed on January 8, 2004, without an executed oath or declaration. Accordingly, on April 21, 2004, applicants were mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted (Notice)," requiring an executed oath or declaration and a surcharge for its late filing. This Notice set a two-month period for reply with extensions of time obtainable under § 1.136(a).

In response, applicants filed the instant petition (and petition fee¹); the late surcharge under § 1.16(e); along with a declaration executed by inventors Durgin and Sakal on behalf of themselves and on behalf of non-signing inventor Trabada. This response was made timely by an accompanying petition (and fee) for extension of time for response within the fifth month.

¹ The petition fee has been charged to Deposit Account No. 50-1492, as authorized.

Applicants assert that status under § 1.47(a) is proper because joint inventor Trabada's refusal after diligent efforts afforded by the assignee to execute the Declaration and Assignment in this application.

A grantable petition under 37 C.F.R. § 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or found, after diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. The instant petition does not satisfy requirement (1).

Petitioner has not shown that inventor Trabada has refused to join in the application. Before a refusal can be alleged, applicants must demonstrate that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. See MPEP 409.03(d). The evidence only supports a conclusion that attempts to present the declaration, assignment and PCT power of attorney to inventor Trabada were made. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Thus, on renewed petition, applicants must establish that the entire application package, including specification, claims and drawings, was presented to non-signing inventor Trabada and he subsequently refused to sign. If they have not already been sent, a copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the inventor is represented by counsel, to the address of the non-signing inventor's attorney.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
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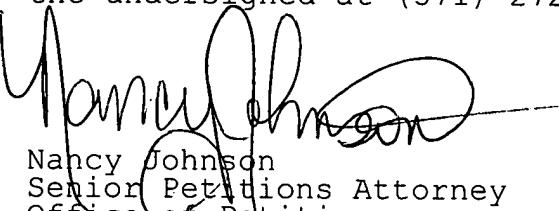
By FAX: (703) 872-9306
ATTN: NANCY JOHNSON
SENIOR PETITIONS ATTORNEY

By hand:

Effective June 5, 2004, patent correspondence delivered by hand or delivery services, other than the USPS, to the Customer Window must be addressed as follows:

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Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.



Nancy Johnson
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Office of Petitions